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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING
2 UNITED STATES PATENT AND TRADEMARK OFFICE

3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7 Ex parte MASAOU MATSUDA, MAKI SATO,
8 SHOICHI GYOBU,
9 FUMIKAZU YOSHIDA,
10 MUNEKAZA OKUHARA,
11 TAKASHI DOKE,
12 HIDEO TAKEUCHI,
13 and
14 KENJI SHIMIZU
15

16 Appeal 2008-4913
17 Application 09/889,508
18 Technology Center 1700
19

20
21 Oral Hearing Held: November 5, 2008
22

23 Before EDWARD C. KIMLIN, CHUNG K. PAK, and
24 LINDA M. GAUDETTE, Administrative Patent Judges
25

26 ON BEHALF OF THE APPELLANT:

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1 The above-entitled matter came on for hearing on Wednesday,
2 November 5, 2008, commencing at 1:42 p.m., at the offices of the U.S.
3 Patent and Trademark, 600 Dulany Street, Alexandria, Virginia, before
4 Mario A. Rodriguez, CMRS, CCR No. 0315162, Notary Public.

5 MR. BOCKMAN: Good afternoon, Your Honors.

6 JUDGE KIMLIN: Whenever you are ready.

7 MR. BOCKMAN: My name is Jonathan Bockman. I represent
8 real party in interest, Toyo Bosoki.

9 I'm going to start off by just going over the claimed invention
10 briefly, and then I'm going to explain the differences between the claimed
11 invention and the cited prior art.

12 What applicants are claiming here, I'm going to start off with
13 claim 1, the only independent claim, so I'm going to focus everything on that
14 one, is a flame retardant polyester fiber which is important that it's a fiber
15 and not just a polyester.

16 A polyester fiber is -- the characteristics of polyester fiber are
17 dictated by both composition of the fiber itself and the process in which the
18 fiber is made.

19 As in a polyester film, you can orient the polyester molecules in
20 different ways to impart different properties, and the way that you impart
21 these different properties include selecting different draw ratios which pull
22 the molecules into alignment, choosing different take up speeds and
23 choosing different set temperatures for the finish fiber.

24 Claim 1 claims a composition -- claims the fiber by reciting
25 composition conditions and properties of the fiber.

26 The composition is a copolymerized polyester with

1 phosphorous in the side chain. The phosphorous imparts the flame
2 retardancy. And the phosphorous composition is present in the amount of
3 500 to 50,000 parts per million.

4 The process of making it is also recited in here. It's melt-spun
5 at a take-up speed of 1,000 meters per minute to 4500 meters per minute.

6 And then we get to the properties of the fiber. And if you look
7 at formulas 1 through 3, these are formulas that reflect different orientation
8 properties of the polyester molecules within the fiber.

9 Applicants found out that if you orient the polyester correctly,
10 you can impart good dyeability of the fiber; typically, a lot of these polyester
11 fibers do not dye very well because the fibers are very dense and they don't
12 take up dye very well. So they have found out that you can impart good
13 dyeability, good abrasion resistance, by choosing the right conditions to
14 manufacture the fiber under.

15 So that is formulas 1 through 3.

16 In addition, the shrinkage in hot water, the dimensional stability
17 of the fiber is claimed and the abrasion resistance of the fiber is also
18 claimed.

19 So that, briefly, is the claimed fiber.

20 Now I'm going to go into discussing the prior art and I'm going
21 to start with a reference that applicants have already overcome, but I'm
22 going to start with that because we kind of went full circle in this
23 application, so the arguments that we presented there are applicable to the
24 references that are currently being cited.

25 That references the Endo patent, U.S. Patent 4,157,436. The
26 examiner cited this reference as disclosing a polyester with the same

1 composition as claimed.

2 Applicants pointed out that the claim take-up speed was not
3 used and that they used a completely different draw ratio than what was used
4 in the specification to impart the properties disclosed in formulas 1 through
5 3.

6 At that time the examiner stated that it looked like those
7 properties would be inherent because the composition was the same, and
8 under In re Fitzgerald, said that it was the applicant's burden to show that
9 those properties would not be inherent and would somehow be dictated by
10 the conditions in which the polyester fibers are produced.

11 In response to that, applicants provided the declaration of Mr.
12 Nakamura.

13 Mr. Nakamura produced -- reproduced the polyester disclosed
14 in Endo and then manufactured the fiber in two different ways. One way
15 using the process disclosed in Endo including a draw ratio of 4.6, and then
16 did it at the lower draw ratio disclosed in our specification as imparting the
17 characteristics disclosed in formulas 1 through 3.

18 JUDGE KIMLIN: Mr. Bockman, was this declaration evidence
19 argued in the brief and responded to by the examiner?

20 MR. BOCKMAN: It was disclosed in the reply brief.

21 JUDGE KIMLIN: In the reply brief.

22 MR. BOCKMAN: It was originally disclosed -- the examiner -
23 - the examiner's answer said that, No evidence had been made of record in
24 the case, that the draw ratio --

25 JUDGE KIMLIN: He was relying upon your reply brief not
26 citing the evidence.

1 MR. BOCKMAN: But it had been made of record within the --

2 JUDGE KIMLIN: But you're well aware of the rules that any
3 arguments that you are going to rely upon as evidence has to be in the brief.

4 MR. BOCKMAN: Okay. But -- we were replying to -- I mean,
5 the examiner did not make this argument until the examiner's answers that
6 there was no evidence in the record that these characteristics were -- the
7 examiner brought up for the first time that there was no evidence in the
8 record that the process conditions were -- affected the fiber, so we in the
9 reply brief just pointed out that, yes, those had been made of record prior.

10 So we were just referring to the examiner's assertion that those
11 hadn't been.

12 JUDGE KIMLIN: I understand.

13 MR. BOCKMAN: So once the examiner accepted the
14 argument that Endo did not disclose the process conditions and that the fiber
15 would be different, and dropped the rejection in view of Endo, but in place
16 of that rejection, then substituted the present references which are Tashiro
17 and Leumer.

18 Tashiro just like Endo fails to disclose the take-up speed and
19 has a higher draw ratio than what the specification discloses as resulting in
20 satisfaction of formulas 1 through 3.

21 The examiner agreed with that, but then cited to Leumer as
22 teaching the claimed take-up speed and teaching that the draw ratio is
23 important.

24 What Leumer teaches, actually, though, is that you want to
25 increase the draw ratio and they say a draw ratio of 4.5 to 6 should be used
26 which is -- starts at where Endo was and goes higher.

1 And the reason why they are doing that is because they are
2 trying to produce a polyester fiber with high strength for industrial
3 application for like tents and the like.

4 To get these high strengths, they have to align the molecules by
5 pulling -- you know, by using a very high draw ratio which actually teaches
6 against what we're doing which is using a lower draw ratio to allow
7 dyeability to be improved.

8 Leumer, Tashiro and Endo fail to disclose any relationship
9 between dyeing properties and using the claimed formulas to obtain that.

10 JUDGE GAUDETTE: Well, you mentioned the draw ratio, but
11 that's not actually claimed in claim 1, is it?

12 MR. BOCKMAN: It is not. What is claimed in claim 1 is the
13 formulas 1 through 3 which are as disclosed in the specification rely on a
14 lower draw ratio than what is used in the Leumer and Endo.

15 JUDGE GAUDETTE: I guess it -- I was looking at your
16 comparative examples and it wasn't totally clear to me that draw ratio was
17 really the determinative factor because, for example, comparative example
18 3, you do have a higher -- slightly higher draw ratio, 2.92, and from what I
19 see here it appears to me that all the formulas are satisfied even at that draw
20 ratio.

21 Although I don't specifically see formula 2 and maybe that's
22 what's different, but I can't tell from the table.

23 MR. BOCKMAN: Yeah, it's at 2.92 which is still -- Endo and
24 Leumer which are cited for the draw ratio are still at the 4.5 and above
25 range.

26 JUDGE GAUDETTE: Well, the one is 3.5, actually.

1 MR. BOCKMAN: Right. Tashiro which fails to show the
2 take-up speed, right.

3 JUDGE GAUDETTE: Right, but it's the combined teachings of
4 the references, so you've got 3.5, and combined with the secondary reference
5 you've got everything else it appears.

6 We don't really have any evidence that 3.5 would not achieve
7 these formulas.

8 MR. BOCKMAN: Okay. But two different things. The
9 combination with the second one, if you combine with the second one, the
10 second one, if you are using that one actually tells you to use a bigger draw
11 ratio.

12 So if you are going to make that combination, it tells you don't
13 use that draw ratio, use a bigger one because they are trying to produce an
14 industrial fiber, and to get that they say you have to use a higher draw ratio
15 to get the higher strength.

16 So if you are going to rely on Leumer as teaching that
17 characteristic, it would tell you to also increase the draw ratio.

18 None of the references tell you any reason to maintain the draw
19 ratio and the take-up speed to obtain higher dyeability or any other -- or the
20 abrasion resistance that we claim.

21 JUDGE GAUDETTE: Well, the examiner's finding is simply
22 that you would want to use that particular spinning take-off speed in order to
23 improve production speed, have a low shrinkage level, so I think that's just
24 relying on secondary references for that limited purpose.

25 MR. BOCKMAN: I'm a little confused because he's relying on
26 Leumer to also show that the draw ratio is a result of -- affects the results of

1 the completed fiber so that somebody would change the draw ratio to get
2 better results, but Leumer actually teaches to increase it much higher than
3 we are and shows no reason why to decrease it.

4 And Tashiro, although it does say three and a half, it's the draw
5 ratio, you know, is -- needs to be -- it's both the draw ratio and the take-up
6 speed that produce those results in addition to the temperature at which it's
7 set.

8 So, I mean, it's not just the draw ratio as you pointed out. We
9 would have just put in the draw ratio into the claim itself. It's a combination
10 of all those properties that produce a flame retardant fiber that satisfies those
11 formulas.

12 JUDGE PAK: Counsel, can you tell me how is the answer
13 different from the final rejection. I notice that the final rejection seemed to
14 make the same assertion as in the answer.

15 And then you said that your reference to the evidence for the
16 first time is necessitated by the examiner's answer, but final rejection seems
17 to say the same thing: Essentially, that you're relying on Fitzgerald that is
18 shifting the burden to you to prove that the product of the prior art does not
19 have your recited properties.

20 So it seems that you had an opportunity to present that evidence
21 in your opening brief but you did not do so.

22 MR. BOCKMAN: You're saying in the final office action they
23 made the same --

24 JUDGE PAK: They indicated that the applicant failed to
25 provide evidence to support applicant's arguments.

26 And also he mentioned because of claimed properties argument

1 to be inherent in the prior art, because of the similarity of the products, that
2 the -- unless you show the evidence, that you cannot -- that you have the
3 burden of showing the evidence that the claimed product is patentably
4 different from the prior art product.

5 MR. BOCKMAN: In the final office action the examiner made
6 two arguments and I -- you know, we had made that argument before about
7 the Endo evidence being applicable to Leumer and to Tashiro, but then the
8 new part of the office action which I guess we focused on was the fact that --
9 the examiner said, "Applicant indicates that the draw ratio taught by Leumer
10 is 4.5 to 6, however, column 8, lines 55 to 65, Leumer teaches that the draw
11 ratio is 1 to 4.5 to 1 to 6 and thought that that encompassed the same range.

12 We were pointing out we thought that was where the examiner
13 was relying on Leumer to claim -- to show the same ratio as disclosed in the
14 specification, but the examiner was actually reading that wrong and a draw
15 ratio of 1.4 or 5 to 1.6 is equal to the draw ratio of 4.5 to 6.

16 So we explained that those are different and because the
17 properties are different, they would not necessarily result in a fiber with the
18 claimed characteristics.

19 It is the examiner's burden to show that that would be the
20 necessary result of --

21 JUDGE PAK: Under In re Spada and In re Best, the
22 examiner's burden is to show that the product are either identical or
23 substantially identical because the examiner does not have means to
24 experiment with the products by showing either identical or similar identity
25 of the products allows the examiner to shift the burden to the applicant to
26 show the claimed product is, in fact, materially or patentably different from

1 the prior product which the examiner stated in the -- page 3 of the final
2 office action.

3 So you had an opportunity to submit evidence to show your
4 product is patentably different from that of the prior art.

5 MR. BOCKMAN: Okay. Just in response, I believe we did
6 that. Both Tashiro and Leumer, specifically Leumer itself, talks about the
7 importance of the draw ratio in imparting characteristics to the fiber.

8 So it isn't as if the examiner didn't have any evidence that those
9 characteristics didn't impart different properties to the fiber. It was well-
10 known. It's in both of those references. It's in our spec that that -- those
11 properties are -- those manufacturing properties do affect the overall
12 properties of the fiber.

13 So it was already of record in everything in front of the
14 examiner that that produced a different fiber and would not necessarily be
15 the same fiber.

16 So the examiner knew it was not the same fiber.

17 JUDGE PAK: (Nodding.)

18 JUDGE KIMLIN: Any further questions?

19 JUDGE GAUDETTE: No.

20 JUDGE PAK: No.

21 JUDGE KIMLIN: I think we understand the issues. Do you
22 have anything further?

23 MR. BOCKMAN: No, I think that's everything I had. Maybe
24 not in the order I had planned to produce it but...

25 JUDGE KIMLIN: It never turns out that way.

26 Well, thank you for coming.

- 1 MR. BOCKMAN: Thank you.
- 2 Whereupon, the proceedings at 2:05 p.m. were concluded.